UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514

Baxley

Mailed: February 9, 2004

Opposition No. **91120519**

EXXON MOBIL CORPORATION

v.

DATAWORX B.V.

Before Bottorff, Rogers and Drost,
Administrative Trademark Judges.

By the Board:

Dataworx B.V. ("applicant") seeks to register the mark DEXXON in typed form for "computers and computer peripherals; optical appliances and instruments, namely, optical disk readers; computer storage devices and media, namely, blank optical disks; blank audio disks; blank audio cassette tapes; blank re-writeable CD-ROM disks; head cleaning cartridges for computer storage devices and data storage equipment; blank computer hard disks; removable disks and tape backup drives for computers; blank digital linear tape cartridges; blank 4 mm and 8 mm computer storage tapes; blank removable three and half inch and five and quarter inch floppy disks" in International Class 9.[1]

[1] Application Serial No. 75511805, filed July 1, 1998 based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15. U.S.C. Section 1051(b), and claiming a right of priority under Trademark Act Sections 44(d)

Registration has been opposed by Exxon Mobil Corporation ("opposer") on the grounds of likelihood of confusion with its "family" of previously used and registered EXXON and "interlocking XX" marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d),[2] false suggestion of a connection with opposer under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a), and dilution of its family of previously used and registered EXXON and stylized XX marks under Trademark Act Section 43(c), 15 U.S.C. Section 1125(c). Applicant denied the salient allegations of the notice of opposition in its answer.

This case now comes up for consideration of opposer's motion (filed September 10, 2003) for summary judgment only on the ground that applicant has failed during discovery to demonstrate a bona fide intent to use the involved mark for

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and (e), 15 U.S.C. Sections 1126(d) and (e), of January 12, 1998 based on a foreign application which matured into Benelux Registration No. 623636.

[2] Opposer's twenty-eight pleaded registrations include the following:

Registration No. 884419 for EXXON in typed form for "industrial chemical additives and processing aids for improving and altering characteristics and performance of petroleum products" in U.S. Class 6 (International Classes 1-5).

Registration No. 1376435 for EXXGARD in typed form for "lubrication analysis services" in International Class 42.

Registration No. 1384919 for XX in the following stylized form:

for "motor oils" in International Class 4.

the recited goods in the United States. The motion has been fully briefed.[3]

We note that opposer did not plead in its notice of opposition that applicant lacks a bona fide intent to use the mark in commerce under Section 1(b) as a ground for opposing registration of applicant's mark, and that opposer has not filed a motion for leave to amend its notice of opposition under Fed. R. Civ. P. 15(a) to assert such ground. Nonetheless, in view of the fact that applicant did not object on this basis and argued against opposer's motion for summary judgment on the merits, we elect to treat the notice of opposition as having been amended to assert the ground and to treat the answer as having been amended to deny the ground. See Fed. R. Civ. P. 56(a) and (b); and TBMP Section 528.07(a) and cases cited therein.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). Opposer, as the party moving for summary judgment, has the initial burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987);

[3] In our discretion, we have considered opposer's reply brief because it clarifies the issues before us. See Trademark Rule 2.127(a).

Sweats Fashions Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). Applicant, as the nonmoving party, must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

After reviewing the parties' arguments and supporting papers, we find that opposer has failed to meet its burden of establishing that there is no genuine issue of material fact with regard to its standing[4] and with regard to whether applicant has a bona fide intent to use the mark on the involved goods in the United States. Rather, we find that the evidence of applicant's activities as a distributor of the involved goods throughout Europe, which opposer submitted as exhibits in support of its motion for summary judgment, is sufficient to raise a genuine issue of material fact with regard to whether applicant has a bona fide intent

[4] We note that opposer did not properly make of record current status and title copies of any pleaded registrations with its notice of opposition and did not submit status and title copies of any pleaded registrations or evidence to establish its prior use of any of its pleaded marks with its motion for summary judgment. *See King Candy Co. v. Eunice King's Kitchen, Inc.,* 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); Trademark Rule 2.122(d)(1).

to use the mark on the involved goods in commerce. Cf. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) and *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351 (TTAB 1994).

In view thereof, opposer's motion for summary judgment is hereby denied.[5]

Proceedings herein are resumed. Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	**3/12/04**
Plaintiff's thirty-day testimony period to close:	**6/10/04**
Defendant's thirty-day testimony period to close:	**8/9/04**
Fifteen-day rebuttal testimony period to close:	**9/23/04**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

[5] The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).